



Press release dated November 27, 2018

BARDEHLE PAGENBERG victorious in design litigation as German Federal Supreme Court sides with Nintendo against Bigben.

On October 17, 2018, the German Federal Supreme Court dismissed an appeal (Case I ZR 28/18) brought by Bigben Interactive GmbH and Bigben Interactive S.A. against refusal of leave to appeal a decision issued, on January 20, 2018 (Case I-20 U 140/16), by the Duesseldorf Appeal Court in design infringement proceedings brought by Nintendo Co., Ltd. in 2014 which had confirmed a decision of the Duesseldorf District Court of October 11, 2016 (Case 14c O 234/14) in favour of Nintendo. Nintendo is represented by BARDEHLE PAGENBERG.

The appeal was dismissed by the Federal Supreme Court with an Order without any substantiation, merely stating that the case did not merit review because it did not raise issues of law of basic importance and the contested decision was adopted without infringement of procedural rights. The Supreme Court's decision is final.

The underlying complaint relates to the infringement of a German design registration, protecting the shape of a controller for game consoles, granted under the former German design law and published on July 25, 2001, claiming priority from a Japanese design patent application.

Overall, this dispute is remarkable for three reasons:

First, this case is one of the rare disputes where a German design registered under the former German Designs Act is enforced. The case is even more remarkable as the design was found both valid (upon a counter-claim for a declaration of invalidity to be decided under the old, non-harmonized law) and infringed (to be decided under the current, harmonized law).

Second, the Duesseldorf Appeal Court, on the merits, accepted additional and new evidence of prior art but found the claimed design to be new and have individuality over the existing design corpus (priority date: August 11, 2000). Particularly, the Court sided with Nintendo and held that the asserted design's overall impression "(...) significantly deviates from what was known before in case of both individual consideration or combination (...)." In this respect, the prior German law, different from current EU design law, required that individuality was to be assessed in relation to the submitted prior art as a whole, and not merely in relation to each individual prior design.

**BARDEHLE
PAGENBERG**

Prinzregentenplatz 7
81675 München
T +49.(0)89.928 05-0
F +49.(0)89.928 05-444
info@bardehle.de
www.bardehle.com

BARDEHLE PAGENBERG
Partnerschaft mbB
Patentanwälte Rechtsanwälte
Amtsgericht München
Partnerschaftsregister 1152
ISO 9001 certified

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Third, the Duesseldorf Appeal Court agreed with the District Court who had accepted claims against Bigben Interactive S.A., the parent of Bigben Interactive GmbH established in France, from where the infringing products were supplied to Germany where the design is protected. The Appeal Court held that Bigben Interactive S.A. was liable without any limitation, either as co-perpetrator (“Mittäter”) or for instigation (“Anstiftung”) or as an accomplice (“Gehilfe”).

Representatives of Nintendo Co. Ltd.:

BARDEHLE PAGENBERG (Munich)

Dr. Henning Hartwig (Attorney-at-Law, Partner)

Prof. Dr. Alexander von Mühlendahl, J.D., LL.M. (Attorney-at-Law)

Dr. Gabriel Wittmann (Attorney-at-Law)

Prof. Dr. Christian Rohnke (Attorney-at-Law, German Federal Supreme Court)

Inhouse: Koni Nishiura (Kyoto), Dr. Peggy Müller (Frankfurt am Main)

Representatives of Bigben Interactive S.A. und Bigben Interactive GmbH:

FPS Fritze Wicke Seelig (Hamburg)

Dr. Frank Hagemann (Attorney-at-Law)

Christian Hertz-Eichenrode (Attorney-at-Law)

Götz Jordan (Attorney-at-Law, German Federal Supreme Court)

BARDEHLE PAGENBERG combines the professional expertise of attorneys-at-law, patent attorneys, professional representatives before the European Patent Office, specialized trademark lawyers and qualified technical consultants. Our consulting services are tailored to our clients' individual needs and the specific circumstances of each case.

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Press contact:

Gabriela Tröger

Marketing & PR

Prinzregentenplatz 7

81675 Munich

T +49.(0)89.928 05-0

F +49.(0)89.928 05-444

gabriela.troeger@bardehle.de

www.bardehle.com